

Application No.: 10/602,055  
Art Unit: 3739

Attorney Docket No. 9052.01  
Confirmation No. 7631

## REMARKS

By the present amendment, Applicant has amended Claims 1 and 3-10, cancelled Claims 12-20, and added Claim 21. Claims 1-11 and 21 remain pending in the present application. Claims 1, 4 and 9 are independent claims.

Claims 12-20 were held withdrawn from consideration by the Examiner as being directed to a non-elected invention, a method for manufacturing a stone therapy apparatus. Accordingly, it is proposed herein that the instant claims be cancelled to expedite prosecution of the present application. However, it should be noted that under the provisions of 35 U.S.C. § 121 Applicant reserves the right to file a divisional application directed to the non-elected subject matter.

In the recent Office Action the Examiner objected to Claim 3 as lacking proper antecedent basis for certain claim language. Claims 1, 3, 5, 6, and 8-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Herbranson. Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Lee. Claims 2, 7, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Herbranson in view of design choice. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Herbranson in view of Mochizuki and Chia et al.

With regard to the Examiner's objection to Claim 3 for reciting "the mechanism of attachment," Applicant has amended the instant claim to delete this terminology. Applicant respectfully submits that every limitation recited in the claim find has proper antecedent basis.

Regarding the prior art rejections, Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Claim 4 has been rewritten in independent form, and Applicant has further amended independent Claims 1 and 9 to include the limitation that the at least one elongated flexible member is embedded in the stones. Applicant respectfully submits that these amendments patentably distinguish the presently claimed invention over the prior art applied of record.

The Examiner rejected Claims 1, 3, 5, 6, and 8-10 under 35 U.S.C. 102(b), as being anticipated by Herbranson. This rejection is respectfully traversed.

Regarding Claims 1 and 9, the Examiner asserts that Herbranson discloses a thermal device comprising an elongated flexible member and a plurality of stones connected to each other via the elongated flexible member. The Examiner further asserts that although the stones in Herbranson are used for a cooling therapeutic manner, the stones inherently have good thermal capacity and therefore could readily serve as heating means. The Examiner, however, fails to address the limitation in original Claim 9 that the distribution of stones on a person's body does not substantially affect the mobility of the person. Moreover, Herbranson fails to teach that the elongated flexible member is embedded in the stones as both Claims 1 and 9 as amended recite. For this reason, the rejection under 35 U.S.C. 102(b), as being anticipated by Herbranson, has been obviated.

Regarding Claim 3, the Examiner asserts that the method of manufacturing carries little to almost no weight when considering an apparatus claim. This assertion, however, contradicts Patent Office policy. MPEP § 2113 states that product-by-process claims, while not limited to the manipulations of the recited steps, are limited by the structure implied by the steps. Claim 3 recites means of attachment between the stone and the elongated flexible member, which do yield structural differences between the Applicant's invention and Herbranson. Further, Claim 3 does not recite a method step of attaching the stones to the elongated flexible member but recites different structural means which form an attachment between the stone and the elongated flexible member, all of which have the common feature of the end of the elongated flexible member being somewhat embedded within the stones, a structure not taught nor implied by Herbranson. Applicant respectfully submits that this rejection over Claim 3 is improper. Applicant respectfully requests reconsideration.

Regarding Claims 5 and 10, the Examiner asserts that Herbranson is capable of being secured about the shoulder by placing it around one shoulder and under the armpit of that same shoulder. Applicant has amended Claims 5 and 10 to recite structural differences between the Applicant's invention and the apparatus as taught by Herbranson.

Regarding Claims 6 and 8, the Examiner asserts that Herbranson is capable of being secured about the neck and therefore part of the spine. Applicant has amended Claims 6 and 8 to recite structural differences between the Applicant's invention and the apparatus as taught by Herbranson. For these reasons, reconsideration of the rejection as being anticipated by Herbranson, is respectfully requested.

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The Examiner rejected Claim 1 under 35 U.S.C. 102(b), as being anticipated by Lee. This rejection is respectfully traversed.

The Examiner asserts that Lee discloses a necklace comprising an elongated flexible member and a plurality of stones connected to each other via the elongated flexible member and that the stones inherently have thermal capacity and therefore could easily serve as heating means. Lee does not, however, teach a unusually high heat capacity for the rhinestones and does not teach sufficiently large sizes of the stones in order to make the disclosed necklace suitable to apply hot stone therapy to a person. The stones of Lee also face outward making it difficult for the stones to directly contact a wearer. Although the Examiner may contend that use of the Applicant's invention for hot stone therapy is an intended use, the Examiner must show that the prior art is capable of performing this intended use. Lee fails to teach that the elongated flexible member is embedded in the stones as recited in Claim 1 as amended. For this reason this rejection under 35 U.S.C. 102(b), as being anticipated by Lee, has been obviated.

The Examiner rejected Claims 2, 7 and 11 under 35 U.S.C. 103(a) as being unpatentable over Herbranson in view of design choice. This rejection is respectfully traversed. Applicant notes that the use of obvious design choice without citing a supporting reference is contrary to Patent Office policy.

Regarding Claims 2 and 11, the Examiner asserts that the Applicant does not disclose that natural river stones provide an advantage, are used for a particular purpose, or solve a stated problem. The Examiner therefore concludes that one of ordinary skill in the art would have expected Applicant's invention to perform equally well with any type of stone/rock with a good heat capacity because it will provide the

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necessary heating/cooling capabilities. The Examiner's allegation that using natural river stones is an obvious design choice is not supported by the prior art of record. If the Examiner has personal knowledge backing up this assertion, the Examiner is requested to provide an affidavit under Section 1.104. In *In re Chu*, 66 F.3d 292, 36 USPPQ2d 1089 (Fed. Cir. 1995), the court instructs that the Examiner must provide reasoning why a specific feature is a matter of design choice and therefore obvious. The Examiner has failed to assert any reason supported by the prior art that the use of natural river stones is an obvious design choice. The Applicant maintains that natural river stones provide natural smooth surfaces that are particularly suitable for Applicant's disclosed purposes. Applicant respectfully requests reconsideration.

Regarding Claim 7, the Examiner asserts that it would have been a matter of obvious design choice to make the device of Herbranson with a longer elongated elastic member so that the device could surround different body parts in order to provide other body parts with thermal therapy. The Examiner, however, fails to provide any prior art teaching stating that it is desired to provide thermal therapy to other parts of the body. For this reason, this rejection is improper. Applicant respectfully requests reconsideration.

The Examiner rejected Claim 4 under 35 U.S.C. 103(a) as being unpatentable over Herbranson in view of Mochizuki and Chia et al. This rejection is respectfully traversed.

The Examiner fails to discuss Herbranson in the discussion of this rejection but instead discusses Lee. For this reason this rejection is improper and the Applicant respectfully requests reconsideration.

Herbranson, Lee, Mochizuki, and Chia et al. further all fail to teach a duplex arrangement. Mochizuki and Chia et al. both teach parallel strands of beads, but a duplex relationship is here two parallel

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elongated elastic members connect through the same stones. There is further no motivation to combine Mochizuki and Chia et al. with Herbranson because Herbranson teaches a therapy device while Mochizuki and Chia et al. both teach decorative jewelry. For this reason, this rejection is improper and the Applicant respectfully requests reconsideration.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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